

recording, in said portable electronic device (5A) and said management center (3A), information on a loan made to the user of said portable electronic device (5A) up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said portable electronic device (5A),

wherein said management center (3A) calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan.

The Final Office Action contends that Figure 2a and 2b and 5 and 10 show the format of the data storage in the IC (Final Office Action at pages 2-3).

In response, Figure 2a and 2b and 5 and 10 of Nonaka fail to show the format of the data storage in the IC. Instead, Nonaka arguably teaches the presence of the personal information storage 34 in the center 3 (Nonaka at Figure 1, page 19, line 23 to page 20, line 5). Figures 2a and 2b and 5 and 10 of Nonaka depict reference number 34.

Also note that the IC card of Nonaka is described as reference number 1 (Nonaka at Figure 1, page 6, lines 22-23), which is shown within Figure 1 to be different than the personal information storage 34.

However, Nonaka fails to disclose, teach or suggest a management center that calculates interest on the loan at a predetermined frequency, and uses the calculation result to update the information on the loan.

Nevertheless, the Final Office Action contends, without providing any supporting evidence, that Nonaka clearly teaches a management center providing a loan to a customer and recording the loan data at both the management center and a portable device of the user (Final Office Action at page 7).

In response to this contention, please note that Nonaka is silent regarding any interest calculation.

But as a gap-filler, the Final Office Action contend, *without providing any supporting evidence*, that charging interest on the loan amount is inherent in the system of Nonaka (Final Office Action at pages 7-8).

In response, this contention is conclusory and is not based upon any objective teaching found within Nonaka.

In particular, inherency requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

The Courts *have not* upheld arguments based on ‘inherent’ properties when there is no supporting teaching in the prior art” (emphasis added). *In re Dillon*, 13 USPQ2d 1337, 1348 (Fed. Cir. 1989). Instead, the Office Action must provide rationale or evidence tending to show inherency. M.P.E.P. §2112(IV).

Rejections under 35 U.S.C. §103 are found within the Office Action. In this regard, “the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown” (emphasis added). *In re Spormann*, 150 USPQ 449, 452 (CCPA 1966).

A patentable invention, within the ambit of 35 U.S.C. §103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. *In re Sponnoble*, 160 USPQ 237, 243 (CCPA 1969).

In addition, “such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection” (emphasis added). *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Also within claim 1, information on a loan is recorded in both the portable electronic device (5A) and the management center (3A).

However, Nonaka fails to disclose, teach or suggest information on a loan is recorded in both the IC Card 1 and the center 3 of Nonaka.

Paragraph 3 of the Final Office Action includes a rejection of claims 9-23 under 35 U.S.C. 102 as being anticipated by Nonaka.

This rejection is traversed at least for the following reasons.

Paragraph 2 of the Final Office Action includes a rejection of claims 9-23 under 35 U.S.C. **103(a)** as being unpatentable over Nonaka. According, a rejection in paragraph 3 of claims 9-23 under 35 U.S.C. **102** as being anticipated by Nonaka is inconsistent with other actions taken by the Examiner within paragraph 2 of the Final Office Action.

Claims 9-16 - Claims 10-16 are dependent upon claim 9. Claim 9 is drawn to an electronic-money settlement method comprising the steps of:

loading electronic money from a portable electronic device (5A) into an information processing apparatus, said electronic money having a monetary value;

establishing a loan when a payment amount exceeds said monetary value of said electronic money, said payment amount being a purchase price of a commodity; and

recording said loan in said portable electronic device (5A).

Nonaka fails to disclose, teach or suggest the means for recording the loan in the IC Card 1 of Nonaka.

Claims 17-23 - Claims 18-23 are dependent upon claim 17. Claim 17 is drawn to an electronic-money settlement apparatus comprising:

information processing means for establishing a loan when a payment amount exceeds a monetary value of electronic money, said payment amount being a purchase price of a commodity;

means for loading said electronic money from a portable electronic device (5A) to said information processing means, said electronic money having said monetary value; and

means for recording said loan in said portable electronic device (5A).

Nonaka fails to disclose, teach or suggest the means for recording the loan in the IC Card 1 of Nonaka.

Conclusion

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: October 19, 2006

Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorney for Applicant